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09/745,011	12/20/2000	Paul Gulko	GFM-00101	7233

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EXAMINER

FRENEL, VANEL

ART UNIT PAPER NUMBER

3626

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/745,011

Applicant(s)

GULKO ET AL.

Examiner

Vanel Frenel

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### Notice to Applicant

1. This communication is in response to the application filed 12/12/00. Claims 1-64 are pending.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-6, 12-33, and 34-66 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

(A) The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 1 nominally recites "a method executed in a computer system for managing monies and information in connection with an insurance

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insolvency ” but do not clearly and definitely utilize any technological device in performing the various claimed steps.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

In the present case, claim 1 recites “a computer system” in its preamble but does not recite any technological device in the body of the claim in performing the various steps of “processing” within the computer system.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

In the present case, claim 1 as a whole are directed to a method for designating a state fund for each state associated with said insurance insolvency.

As such, this invention produces a useful, concrete, and tangible results as associating with said insurance account at least one line of insurance.

Claims 2-6 and 12-33 do not recite any application or use of the technological arts, and thus equally rejected under 35U.S.C. 101.

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(B) Claim 34 is directed to a “computer program product” comprising “machine executable code”. However, in its broadest sense, a computer program product may be a book or print-out of software code. As such, the claim, unless specifically embodied on a computer –readable medium, does not confer statutory status to the claim. At best, the “machine readable code” may simply be non-functional descriptive material (e.g., a computer program) that does not qualify for patent protection. In order to be statutory, there must be a structural and functional interrelationship between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized. Please see MPEP 2106, Section IV B.1.(a). Similar analysis holds for claims 35-66.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et al (5,704,045) in view of Walker et al (6,119,093).

(A) As per claim 1, King discloses a method executed in a computer system for managing monies and information in connection with an insurance insolvency (Col.5, lines 47-67) comprising: designating a state fund for each state associated with said

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insurance insolvency (Col.9, lines 9-26); associating with said state fund an insurance account of a first type (Col.22, lines 45-62).

King does not explicitly disclose associating with said insurance account at least one line of insurance.

However, this feature is known in the art, as evidenced by Walker. In particular, Walker suggests associating with said insurance account at least one line of insurance (See Walker, Col.5, lines 54-65; Col.12, lines 15-40).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Walker within the system of King with the motivation of providing a system whereby ad hoc insurance syndicates can be created, providing many small investors with an opportunity to collect insurance premiums (or portions of insurance premiums) in exchange for an affordable assumption of risk (See Walter, Col.2, lines 40-44).

(B) As per claim 2, Walker discloses the method further comprising: associating at least one industry standard code with said insurance account and said at least one line of insurance (See Walker, Col.5, lines 54-65; Col.12, lines 15-40).

The motivation for combining the respective teachings of King and Walker are as discussed above in the rejection of claim 1, and incorporated herein.

(C) As per claim 3, Walker discloses the method wherein said insurance account is associated with a plurality of lines of insurance (Col.4, lines 47-67).

The motivation for combining the respective teachings of King and Walker are as discussed above in the rejection of claim 1, and incorporated herein.

(D) As per claim 4, King discloses the method wherein said insurance account is associated with at least two lines of insurance each being of type commercial automobile, worker's compensation, homeowner's and fire (Col.18, lines 14-42).

(E) As per claim 5, King discloses the method wherein said insurance account is associated with one line of insurance being of type commercial automobile, worker's compensation, homeowner's and fire (Col.18, lines 14-42).

(F) As per claim 6, King discloses the method further comprising: associating a group with a first of said each states having a corresponding state fund (Col.9, lines 2-26); and associating at least one member with said group (Col.23, lines 17-21).

(G) As per claim 7, Walker discloses the method further comprising: storing information in a computer system representing a relationship between said state fund and said associated insurance account and said at least one line of insurance (Col.6, lines 5-23).

The motivation for combining the respective teachings of King and Walker are as discussed above in the rejection of claim 1, and incorporated herein.

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(H) As per claim 8, Walker discloses the method further comprising: representing a merger of at least two members by combining portions of said information stored in the computer system (Col.6, lines 5-43).

The motivation for combining the respective teachings of King and Walker are as discussed above in the rejection of claim 1, and incorporated herein.

(I) As per claim 9, Walker discloses the method further comprising: modifying a relationship between said at least two members represented in the computer system (Col.12, lines 55-67 to Col.13, line 17).

The motivation for combining the respective teachings of King and Walker are as discussed above in the rejection of claim 1, and incorporated herein.

(J) As per claim 10, King discloses the method further comprising: representing a split of one member into at least two entities using portions of said information stored in the computer system (Col.22, lines 66-67 to Col.23, line 25).

K) As per claim 11, King discloses the method further comprising: modifying a relationship represented in said computer system of said one member corresponding to said split into said at least two entities (Col.22, lines 66-67 to Col.23, line 25).

(L) As per claim 12, King discloses the method further comprising: determining an insurance account from which a payment is made (Col.16, lines 48-67 to Col.17, line 3).



(M) As per claim 13, Walker discloses the method wherein said payment is made in connection with at least one of: a claim and an unearned premium (Col.5, lines 54-65).

The motivation for combining the respective teachings of King and Walker are as discussed above in the rejection of claim 1, and incorporated herein.

(N) As per claim 14, Walker discloses the method further comprising: tracking payments (Col.11, lines 41-52); and displaying an accounting of said payments with respect to a predetermined estimated amount of payments (Col.11, lines 41-52).

The motivation for combining the respective teachings of King and Walker are as discussed above in the rejection of claim 1, and incorporated herein.

(O) As per claim 15, Walker discloses the method further comprising: tracking total payments made prior to said insolvency (Col.6, lines 59-67 to Col.7, line 6).

The motivation for combining the respective teachings of King and Walker are as discussed above in the rejection of claim 1, and incorporated herein.

(P) As per claim 16, King discloses the method further comprising: tracking monies in connection with a recovery amount (Col.11, lines 9-38).

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(Q) As per claim 17, Walker discloses the method of Claim 16, wherein said recovery amount includes at least one of: a salvage amount, a subrogation recovery, a second injury amount, a cost of living adjustment, and net worth (Col.14, lines 20-45).

The motivation for combining the respective teachings of King and Walker are as discussed above in the rejection of claim 1, and incorporated herein.

(R) As per claim 18, Walker discloses the method further comprising: creating a diary entry including information about one of: a claim and unearned premium (Col.13, lines 53-67 to Col.14, line 19); and sending said diary entry to at least one user (Col.11, lines 41-67).

The motivation for combining the respective teachings of King and Walker are as discussed above in the rejection of claim 1, and incorporated herein.

(S) As per claim 19, Walker discloses the method wherein said sending said diary entry is performed automatically in response to an occurrence of a predefined event (Col.11, lines 41-67).

The motivation for combining the respective teachings of King and Walker are as discussed above in the rejection of claim 1, and incorporated herein.

(T) As per claim 20, King discloses the method wherein said predefined event is one of deleting a pending payment, closing one of a claim and an unearned premium, upon rejection of a closing one of a claim and unearned premium, modifying a line of

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insurance, deleting a line of insurance, sending a note to a reviewer, adjusting a reserve, adding a new taxpayer, and modifying an existing taxpayer (Col.21, lines 1-42).

(U) As per claim 21, Walker discloses the method wherein the method further includes: creating an account for a user specifying a predetermined limit (Col.9, lines 11-67 to Col.10, line 23); specifying, by said user, a reserve amount above said predetermined limit (Col.9, lines 1-30); and sending said diary entry to a manager for approval in response to said user specifying said reserve amount (Col.8, lines 36-49).

The motivation for combining the respective teachings of King and Walker are as discussed above in the rejection of claim 1, and incorporated herein.

(V) As per claim 22, Walker discloses the method wherein said sending said diary entry is performed in response to a first user creating said diary entry, and the method further includes: said first user selecting at least one other user to which said diary entry is sent (Col.11, lines 41-67 to Col.12, line 22).

The motivation for combining the respective teachings of King and Walker are as discussed above in the rejection of claim 1, and incorporated herein.

(W) As per claim 23, Walker discloses the method further comprising: associating at least one note with an insurance claim; associating a blocked status with said insurance claim; and generating, in response to setting said blocked status, a note to at least one user indicating why said insurance claim has a blocked status (Col.11, lines 41-52).

The motivation for combining the respective teachings of King and Walker are as discussed above in the rejection of claim 1, and incorporated herein.

(X) As per claim 24, Walker discloses the method further comprising: automatically notifying a first user when a second user attempts to perform a predetermined operation on said insurance claim having said blocked status (Col.11, lines 41-52).

The motivation for combining the respective teachings of King and Walker are as discussed above in the rejection of claim 1, and incorporated herein.

(Y) As per claim 25, Walker discloses the method further comprising: performing a transaction in connection with one of an insurance claim and an unearned premium (Col.13, line 18-34); and determining a corresponding insurance account in accordance with information about said one of said insurance claims and said unearned premium, said information including a relationship to a state and at least one line of insurance associated with said corresponding insurance account (Col.13, line 18-34); and adjusting an amount associated with said corresponding insurance account in accordance with said transaction (Col.12, line 41-67).

The motivation for combining the respective teachings of King and Walker are as discussed above in the rejection of claim 1, and incorporated herein.

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(Z) As per claim 26, King discloses the method further comprising: generating a data file including information about at least one of an unearned premium and a claim, said data file being used as an input file into an accounting system (Col.11, lines 4-9).

(AA) As per claim 27, King discloses the method further comprising: generating general ledger entries, said general ledger entries being included in said data file (Col.11, lines 9-38).

(BB) As per claim 28, King discloses the method further comprising: associating information about an insurance claim with said corresponding insurance account (Col.13, line 18-67 to Col.14, line 18); entering a note associated with an insurance claims, said note including descriptive information about said claim entered by a claim handler (Col.8, lines 41-67; Col.15, lines 1-29); and providing for said note to be available for reading by another user (Col.8, lines 41-67 to Col.9, line 26).

(CC) As per claim 29, Walker discloses the method further comprising: recording information about an error in a log file included in a client system (Col.9, lines 11-25).

The motivation for combining the respective teachings of King and Walker are as discussed above in the rejection of claim 1, and incorporated herein.

(DD) As per claim 30, King discloses the method further comprising: auditing said transaction by recording audit information about said transaction (Col.17, lines 5-45).

(EE) As per claim 31, Walker discloses the method wherein said audit information includes at least one of: date and time information, transaction type, data values prior to modification by said transaction, and user performing said transaction (Col.9, lines 47-67).

The motivation for combining the respective teachings of King and Walker are as discussed above in the rejection of claim 1, and incorporated herein.

(FF) As per claim 32, Walker discloses the method further comprising: generating an incomplete status of a record including information about a claim, obtaining additional information about said claim (Col.9, lines 57-67); modifying said record to include said additional information (Col.12, lines 55-67 to Col.13, line 17); and converting said incomplete status associated with said record to a claim status (Col.13, lines 5-34).

The motivation for combining the respective teachings of King and Walker are as discussed above in the rejection of claim 1, and incorporated herein.

(GG) As per claim 33, Walker discloses the method further comprising: assigning at least one role to a first user have a first set of security permissions and access limits (Col.9, lines 11-35); and determining, using said first set of security permissions and access limits, whether to allow a user to perform an operation in connection with said insurance account (Col.11, lines 41-52).

The motivation for combining the respective teachings of King and Walker are as discussed above in the rejection of claim 1, and incorporated herein.

(HH) As per claim 34, King discloses a computer program product for managing monies and information in connection with an insurance insolvency (Col.5, lines 47-67) comprising: machine executable code for designating a state fund for each state associated with said insurance insolvency, machine executable code for associating with said state fund an insurance account of a first type (Col.9, lines 2-38).

However, King does not explicitly disclose machine executable code for associating with said insurance account at least one line of insurance.

However, this feature is known in the art, as evidenced by Walker. In particular, Walker suggests associating with said insurance account at least one line of insurance (See Walker, Col.5, lines 54-65; Col.12, lines 15-40).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Walker within the system of King with the motivation of providing a system whereby ad hoc insurance syndicates can be created, providing many small investors with an opportunity to collect insurance premiums (or portions of insurance premiums) in exchange for an affordable assumption of risk (See Walter, Col.2, lines 40-44).

(II) Claims 35-66 repeat the subject matter of claims 2-33 and respectively as a set of "machine-executable code" rather than a series of steps. As underlying process of

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claims 2-33 have been shown to be obvious in view of the collective teachings of King and Walker, it is readily apparent that the system disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 35-66 are rejected for the same reasons given above for method claims 2-33, and incorporated herein.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not the applied art teaches method and apparatus of creating financial instrument and administering an adjustable rate loan system (5,742,775), method and apparatus for establishing and enhancing the creditworthiness of intellectual property (6,330,547), method and apparatus for facilitating customer payments to creditors from a remote site (6,119,106) and a report on the proceedings of the Joint Symposium on Insolvency and Secured Transactions by (Charles D. Booth 26-27 Octobre 1999).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on Monday-Thursday from 6:30 am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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V.F

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September 27, 2004

  
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